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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,070	11/26/2003	Paul Shabty	60,301-016	8655

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EXAMINER

DEMILLE, DANTON D

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/723,070

Applicant(s)

SHABTY ET AL.

Examiner

Danton DeMille

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

*Specification*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention.

3. The claims and specification recite that the invention uses "noncompressed air". It is not clear what is meant by this term. It is stated in the specification that noncompressed air is transferred to the cuffs and pressure gauges and transmitters are used to monitor the operation. If the air is pressurized then the air would be compressed. In order to fill the cuffs above normal atmospheric pressure the air would have to be compressed into the cuffs. It is not clear how applicant can use noncompressed air in their system and still be able to apply pressure to the patient. If the air is not compressed and therefore is not under pressure then it would be incapable of applying pressure to the patient. It is not clear how or by what means applicant can achieve a pressurized cuff system with the use of noncompressed air. Applicant discloses using a piston to apply pressure to the patient. How is applicant's noncompressed air system that uses a piston drive different from the prior art system that uses a piston drive?

4. Claims 18-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not adequately described as set forth in the above objection to the specification.

*Claim Rejections - 35 USC § 101*

5. Claims 18-28 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. A noncompressed air system would not appear to provide sufficient pressure to the patient for providing any kind of useful therapy. If the system provides any kind of pressure to the patient then it wouldn't be a noncompressed air system.

6. To any extent the claims are understood and appear to be supported by a clear and complete disclosure the following appears to be appropriate.

*Claim Rejections - 35 USC § 112*

7. Claims 18-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Reciting in the claims of moving noncompressed air in the system to inflate the cuffs does not appear to be accurate. In order to have sufficient pressure within the cuff to apply pressure to the patient the air has to be compressed or pressurized. Noncompressed air would never apply any pressure to the patient. The same would apply to deflating the cuff by moving the noncompressed air from the cuff. If the cuff is inflated the air is pressurized or compressed. Reciting that the air is noncompressed appears inaccurate.

9. It would appear that applicant may have a noncompressed air supply source however, the air downstream of the piston would have to be compressed or pressurized.

10. In claim 18 the next to the last paragraph calls for moving noncompressed air through the conduit away from the cuff. It is not clear how this is any different from the last paragraph that calls for deflating the cuff by moving the noncompressed air through the conduit away from the

cuff. What steps would one be performing to accomplish the first step that wouldn't also be done in the second step? How would one know when they are performing one step and not the other? What is difference between the two?

### *Double Patenting*

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**12. Claims 18-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,736,786.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to provide the method of counterpulsation as recited in the claims.

**13. Claims 18-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,450,981.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to provide the method of counterpulsation as recited in the claims.

14. **Claims 18-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-20 of copending Application No. 10/242,529 in view of Norton et al.** Applicant uses a piston in which to move the air in the instant invention. These prior art device also uses a piston to move the air in the system. Therefore as understood, it would have been obvious to one of ordinary skill in the art to modify the claims in the copending application to use noncompressed air as taught by Norton et al. to provide the means to move the noncompressed air.

15. This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. **Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Norton et al.**

18. Norton teaches in column 10, lines 42-56 that if the volume of air in the system is such that a forward stroke of the piston creates a positive pressure and a backward stroke creates a negative pressure then the system starts out with noncompressed air. This would appear to comprehend the invention as understood.

19. Regarding claim 19, Norton teaches a valve 78 to control the amount of air in the system that includes means to vent to atmosphere when there is too much air in the system as shown in figure 13.


***Claim Rejections - 35 USC § 103***


20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. **Claims 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dye et al. in view of Norton et al.**

22. Figure 1 of Dye teaches a plurality of cuffs and conduits for sequentially inflating and deflating each of the cuffs. The valve 38 sequentially inflates the adjoining upper cuff after a predefined pressure has been achieved in the lower cuff. 28 and 30 provide the pressure source and timing device however, Dye is silent regarding the details. Norton teaches the details of the timing and pressure source means shown in figure 13. As noted above, figure 13 of Norton would appear to provide the claimed noncompressed air supply system. It would have been obvious to one of ordinary skill in the art to modify Dye to use the timing and pressure source as taught by Norton to complete the details of the Dye device providing a conventional pressurized source of air.

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